

Response dated May 10, 2005  
Response to Office Action mailed 02/10/2005

Application No. 10/037,297

**REMARKS**

The Office Action of February 10, 2005 has been reviewed and the comments therein were carefully considered. Claims 1-23 are currently pending. Claims 1-15 and 17-23 stand rejected. Claim 16 is objected to. Through this amendment claims 1, 5 and 22 have been amended. As explained in more detail below, the Applicants submit that all claims are now in condition for allowance and respectfully request such action.

**Claim Rejections Under 35 USC §112**

Claim 5 stands rejected due to the lack of proper antecedent basis for the limitation "the cache server". Through this amendment, claim 5 has been amended to refer to the cache computer recited in claim 1. In view of the amendment, the Applicants respectfully request the withdrawal of this rejection.

**Claims 1 and 22 are Rejected Under 35 USC §102**

Claims 1 and 22 are rejected under 35 USC §102(e) as allegedly being anticipated by Chong, Jr., U.S. Patent No. 6,397,267 ("the '267 patent"). The Applicants traverse the rejection in view of the following Remarks.

The Office Action asserts the '267 patent teaches a method of transferring data between a host computer and a storage device. More specifically, the Office Action alleges that the feature of "receiving a cache request from the second computer device" is somehow found in Col. 7, lines 16-29. It appears from the Office Action that the Examiner is alleging that the claimed "second computer" is met by the host computer 12 of the '267 patent (shown in Figure 4A). The cited text and illustrative figure, however, illustrate "a computer system 30 having a different embodiment of the storage controller 26". (Col. 6, lines 59-60) The illustrative host computer 12

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does not receive a cache request from a second computer." Indeed, the cited text or remainder of the specification do not teach or otherwise disclose a "second computer" or a "cache computer" as claimed in claims 1 and 22.

Indeed, it appears that the Office Action is alleging that the claimed "cache computer" is met by storage controller 26. In order to anticipate the limitation of "receiving at the cache computer non-requested content from the second computer device," the '267 patent would at the very least have to show – receiving at the storage controller, non-requested content from the host computer 12. There is no suggestion for this at all in the '267 patent. As indicated above, it remains unclear to the Applicant which elements of the '267 patent is alleged to anticipate the claimed "first computer device", "second computer device" and "cache computer". If this rejection is maintained, the Applicant respectfully requests that the Office explicitly indicate which elements in the '267 patent meet the claimed "first computer device", "second computer device" and "cache computer".

In contrast to the '267 patent, claims 1 and 22 recite methods and instructions for transmitting a request at a cache computer, wherein a first computer device and a second computer device are coupled to the cache computer. The Applicants, therefore, submit that the '267 patent does not teach each and every limitation of the present application, and respectfully request withdrawal of the rejection.

### **Claim Rejections Under 35 USC §103**

Claims 2-4 are rejected under 35 USC §103(a) as allegedly being unpatentable over Chong, Jr., U.S. Patent No. 6,397,267 in view of Cieslak, et al., U.S. Patent No. 6,832,252 ("the '252 patent"). The Applicants traverse the rejection in view of the following Remarks.

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As discussed above, claim 1 is allowable over the cited art for at least the reasons cited above. Claims 2-4 directly or indirectly depend from claim 1 and are therefore not rendered obvious by the combination of the '267 patent and the '252 patent. Indeed, neither reference teaches or suggests the step of: "receiving at the cache computer non-requested content from the second computer device, wherein the non-requested content is content other than content requested by the first computer device." Claims 1 and 22 have been amended to more clearly indicate the "nonrequested content".

Secondly, there is no motivation to combine the '267 patent with the '252 patent. The Examiner states that "it would have been obvious at the time of the invention for an artisan of ordinary skill to use the invention taught by the '267 patent", however, no motivation to combine the references was provided in the Office Action nor does the prior art suggest a modification of the '267 patent or combination with the '252 patent to arrive at the claimed invention.

In this regard, the '267 patent is directed towards a host computer having a storage controller coupled to a storage device. In contrast, the 252 patent is directed towards methods for caching network data traffic. As a person skilled in the art can readily appreciate, at the time of the present invention, transferring data across a network, such as the world wide web ("web") was restrained by a limited supply of bandwidth. Attempts to prevent congestion while providing the requested information focused on reducing the amount of information that had to be transferred across the limited amount of bandwidth. In fact, the '252 patent expressly acknowledges the bandwidth restraint historically associated with transferring files across the web. (See, e.g., Col. 1, lines 38-41, setting forth "Given the increase of traffic on the World Wide Web and the growing bandwidth demands of ever more sophisticated multimedia content, there has been constant pressure to find more efficient ways to service data requests..."). This is

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not a main factor considered when transferring information from a host computer to a coupled storage device. Therefore, one skilled in the art at the time of the present invention would not be motivated to transmit non-requested data to a computing device across a network, such as the web. Therefore, the Applicants respectfully traverse this ground for rejection and request reconsideration.

Claims 5-9 are rejected under 35 USC §103(a) as being unpatentable over Chong, Jr., U.S. Patent No. 6,397,267 in view of Cieslak, et al., U.S. Patent No. 6,832,252 and further in view of Einarson, et al., U.S. Patent No. 6,704,781 ("the '781 patent"). The Applicants traverse the rejection in view of the following Remarks.

The '267 and '252 patents have been discussed above. The Office Action sets forth that the '781 patent discloses subject matter of the defendant claims such as: payment of a fee by a second computer, requesting an amount of cache memory space, and sending non-requested data, wherein the data comprises object of a web page. As discussed above, there is no motivation to combine the '267 and the '252 patents. Moreover, the '781 patent does not teach or suggest the claimed aspects of the present invention. The Applicants, therefore, respectfully traverse this rejection and request reconsideration.

Claims 10-12 are rejected under 35 USC §103(a) as being unpatentable over Chong, Jr., U.S. Patent No. 6,397,267 in view of Cieslak, et al., U.S. Patent No. 6,832,252 and further in view of Aviani, et al., U.S. Patent No. 5,950,205 ("the '205 patent"). The Applicants traverse the rejection in view of the following Remarks.

The Office Action asserts that column 5, lines 51-56 of the '205 patent discloses receiving the identification of non-requested content at a second computer and receiving memory addresses as the non-requested content.. From the Applicants' understanding, the cited text

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relates to the directory structure of disk drives in the cache memory, wherein the directory is stored in a cache server's volatile memory. (See Col. 5, lines 24-42). While the cited text discusses the probability of receiving a false positive match, the Applicant's do not believe the cited text, or any disclosure in the '205 patent teaches the claimed aspects of the present invention. Furthermore, the Office Action does not provide a motivation to combine the patents, as discussed in more detail below in relation to claim 12.

In regards to claim 12, the Office Action asserts that the '205 patent teaches that any computer can be a cache requester, however, the Office Action fails to state the motivation to combine the '205 patent with the '267 and '252 patents. As discussed above, one skilled in the art at the time of the present invention would not be motivated to combine the '267 and the '252 patents. Moreover, the '205 patent does not teach or suggest the claimed aspects of the present invention. The Applicants, therefore, respectfully traverse this rejection and request reconsideration.

Claims 13-15, 20 and 23 are rejected under 35 USC §103 as being unpatentable over Einarson, et al., U.S. Patent No. 6,704,781 in view of Chong, Jr., U.S. Patent No. 6,397,267. The Applicants traverse the rejection in view of the following Remarks.

The '781 patent is directed towards "offering caching services to servers in a network." (Col. 1, lines 10-11). As discussed above, the '267 patent discloses a single host computer that controls a host storage controller and a storage device. In contrast, the '781 patent teaches caching appliances that "can be used to reduce the amount of bandwidth consumed by an ISP by serving some requests from a local cache." (Col. 1, lines 21-25; emphasis added). Indeed, the caching appliances serve requests from the cache, not unrequested data, as claimed in the present invention. Furthermore, a goal of the '781 patent was to "reduce the amount of bandwidth

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consumed", thereby one skilled in the art would not be motivated by the reference to utilize increase the bandwidth consumption to retrieve unrequested data (Col. 1, lines 22-23). In fact, It can be argued that the '781 patent teaches away from the present invention. The Applicants, therefore, respectfully traverse this rejection and request reconsideration.

Claim 21 is rejected under 35 USC 103(a) as being unpatentable over Linarson, et al., U.S. Patent No. 6,704,781 in view of Cieslak, et al., U.S. Patent No. 5,832,252. The Applicants traverse the rejection in view of the following Remarks.

As discussed above, there is no motivation to combine the '781 and '252 patents. In fact, it can be argued the '781 reference teaches away from the present invention. The Applicants, therefore, respectfully traverse this rejection and request reconsideration.

### CONCLUSION

Applicants therefore respectfully request reconsideration of the pending claims and a finding of their allowability. A notice to this effect is respectfully requested. Please feel free to contact the undersigned should any questions arise with respect to this case that may be addressed by telephone.

Respectfully submitted,

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